

**REMARKS**

In this Amendment, Applicants have amended claims 1, 2, 5, 6, 11, 14, 15, 16, 20, 21, 24, and 45, added new claims 46 and 47, and canceled claims 22 and 26 without prejudice or disclaimer of their subject matter. Claims 3, 4, 9, 10, 29, and 32 were previously canceled. Claims 7, 8, 18, 19, 28, 30, 31, 33-44 were withdrawn. The claim amendments are fully supported by the originally-filed application. For example, the amendments to claim 1 are supported by the specification at ¶¶ [025]-[028], among other places. No new matter has been added. Accordingly, upon entry of this Amendment, claims 1, 2, 5, 6, 11-17, 20, 21, 23-25, 27, 45-47 are currently under examination, among which claims 1, 11, 20, and 24 are independent.

**Priority and Indefiniteness**

Applicants acknowledge with appreciation the Examiner's withdrawal of the objection to Applicants' claim for priority under 35 U.S.C. § 119(e), and the withdrawal of the rejection under 35 U.S.C. § 112, second paragraph.

**Summary**

In the Office Action, the Examiner rejected claims 1, 2, 5, 6, and 20-23 under 35 U.S.C. § 101 because the claimed invention is allegedly directed to non-statutory subject matter; and rejected claims 1, 2, 5, 6, 11-17, 20-27, and 45 under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Patent No. 6,005,945 ("Whitehouse"), in view of U.S. Patent No. 5,019,991 ("Sansone").

**Rejection of claims 1, 2, 5, 6, and 20-23 under 35 U.S.C. § 101**

Applicants respectfully traverse the rejection of claims 1, 2, 5, 6, and 20-23 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Without

conceding with the Office Action's allegations, Applicants have amended independent claims 1 and 20 so that the methods are tied to a particular machine or apparatus. Applicants submit that the subject matter recited in claims 1, 2, 5, 6, and 20-23, as amended, is statutory and meets the "machine-or-transformation" test set forth by the Federal Circuit in *In re Bilski*. Applicants therefore respectfully request withdrawal of the 35 U.S.C. § 101 rejection of claims 1, 2, 5, 6, and 20-23.

Rejection of claims 1, 2, 5, 6, 11-17, 20-27, and 45 under 35 U.S.C. 103(a)

Applicants respectfully traverse the rejection of claims 1, 2, 5, 6, 11-17, 20-27, and 45 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Whitehouse in view of Sansone. A *prima facie* case of obviousness has not been established with respect to claims 1, 2, 5, 6, 11-17, 20-27, and 45.

To establish a *prima facie* case of obviousness, the Office Action must, among other things, properly determine the scope and content of the prior art and properly ascertain the differences between the claimed invention and the prior art. See M.P.E.P. § 2144.08(II)(A). Furthermore, the Office Action must make findings with respect to all of the claim limitations and must provide "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." See M.P.E.P. §§ 2143.03 and 2141(III).

Independent claim 1, as amended, recites, among other things, the following features:

printing, using a printing device, a postage indicia that represents the estimated postage amount, an addressee information, a sender information, a unique postage number that uniquely identifies the postage indicia and prevents duplication of the postage indicia and a unique delivery confirmation number that uniquely identifies the mailpiece,

and a date, wherein the postage indicia represents the estimated postage amount in a format readable by machine only, and represents the address information, the sender information, the unique postage number, and the unique delivery confirmation number in a human readable format.

The Office Action alleges that Whitehouse discloses “printing the estimated postage amount, an addressee information, a sender information, and a date on a postage indicia, the postage indicia including the estimated postage amount in a format readable by machine only. (See at least Fig 5B: item 220 and col13: lines 22-38, col13: lines 55-60).” Office Action, p. 5. Further, the Office Action alleges that Whitehouse’s “‘two dimensional barcode’ teaches the limitation ‘postage indicia including the estimated postage amount in a format readable by machine only’.” *Id.*, p. 6.

Applicants respectfully disagree with the Office Action’s allegations. Applicants submit that in view of the amendments to claim 1, Whitehouse does not teach or suggest, among other things, at least “printing . . . a unique postage number that uniquely identifies the postage indicia and prevents duplication of the postage indicia and a unique delivery confirmation number that uniquely identifies the mailpiece,” wherein the unique postage number and the unique delivery confirmation number are represented “in a human readable format,” as recited in amended claim 1.

Instead, Whitehouse teaches generating a postage indicium “by concatenating a set of data bits representing a predefined sequence of information to be included in every postage indicium.” Whitehouse, col. 13, lines 16-19. Whitehouse also teaches a “postage” and a “Serial Number” as elements being concatenated in the postage indicium. See *Id.*, lines 25-35. Whitehouse further teaches a “license ID and serial number together uniquely identify[ing] each mail piece” (Whitehouse, col. 13, lines 38-

39). Whitehouse further teaches printing “the mail piece label with the indicium and digital signature in the message as a two dimensional barcode.” *Id.*, col. 13, lines 57-59. In other words, as disclosed in Whitehouse, the entire postage indicium that includes the set of data bits including data bits representing the “postage,” the “license ID,” and the “Serial Number,” is printed as a two dimensional barcode, which is not a human readable format, as shown in Fig. 3 of Whitehouse. Therefore, in contrast to claim 1, Whitehouse fails to teach or suggest at least “printing . . . a unique postage number that uniquely identifies the postage indicia and prevents duplication of the postage indicia and a unique delivery confirmation number that uniquely identifies the mailpiece,” wherein the unique postage number and the unique delivery confirmation number are represented “in a human readable format,” as recited in amended claim 1 (emphases added).

The Office Action relies on Sansone to allegedly cure the deficiencies of Whitehouse. Sansone teaches “a system for certifying correctly accounted postage payment.” Sansone, Abstract. Sansone teaches, as shown in Fig. 3, an envelope 100 including a postage data area 110, which may include “a serial number corresponding to the meter from which postage has been applied.” *Id.*, col. 5, lines 40-42. Sansone also teaches a “certification coded area 106,” which may be applied “a specific serial number . . . which may bear an encrypted but no-apparent relationship between the meter number and the certification number.” *Id.*, lines 32-33 and 42-46.

However, the “serial number corresponding to the meter from which postage has been applied” does not teach or suggest the “unique postage number for uniquely identifying the postage and preventing duplication of the postage,” as recited in

amended claim 1, at least because the “serial number corresponding to the meter” disclosed in Sansone does not “uniquely identif[y] the postage indicia,” as required by claim 1. This is because, as known in the art, the “serial number corresponding to the meter” disclosed in Sansone is a fixed number associated with the meter, and the meter may be used to apply postage to multiple mailpieces. Thus, the “serial number corresponding to the meter” may be applied to the postage data area 110 for multiple mailpieces and therefore, cannot uniquely identify the postage and prevent duplication of the postage.

For similar reasons, the “specific serial number” applied to the certification coded area 106 also does not correspond to the claimed “unique delivery confirmation number that uniquely identifies the mailpiece,” as recited in amended claim 1.

Therefore, Sansone does not teach or suggest, among other things, at least “printing . . . a unique postage number that uniquely identifies the postage indicia and prevents duplication of the postage indicia and a unique delivery confirmation number that uniquely identifies the mailpiece,” wherein the unique postage number and the unique delivery confirmation number are represented “in a human readable format,” as recited in amended claim 1. Thus, in contrast to the Office Action’s allegations, Sansone does not cure the deficiencies of Whitehouse.

For at least the foregoing reasons, the Office Action misinterprets the scope and content of the prior art, and Whitehouse and Sansone, whether taken alone or in any combination, fail to teach or suggest the combination of features recited in amended independent claim 1, under a correct determination of the scope and content of the prior art. Moreover, these undisclosed features represent significant differences between the

claimed invention and the prior art. Therefore, a *prima facie* case of obviousness has not been established for independent claim 1, and claim 1 is allowable over the cited references.

Although of different scope, independent claims 11, 20, and 24, as amended, each recites features and combinations similar to those recited in claim 1, which are not taught or suggested by Whitehouse and Sansone. Therefore, independent claims 11, 20, and 24 are also allowable over the cited references for at least the same reasons stated with respect to claim 1. Dependent claims 2, 5, 6, 12-17, 21, 23, 25, 27, and 45 are also allowable at least by virtue of their respective dependence from one of independent claims 1, 11, 20, and 24, as well as by virtue of reciting additional features not disclosed or suggested by the cited references. Applicants therefore respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection.

#### New Claims

Applicants submit that new claims 46 and 47 are allowable at least by virtue of their respective dependence from independent claims 1 and 11, as well as by virtue of reciting additional features not disclosed or suggested by the cited references.

#### Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified

herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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